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10/620,903

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Joseph L. Tallal JR.

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EXAMINER

RAPILLO, KRISTINE K

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |  |  |
|------------------------------|--|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/620,903   | <b>Applicant(s)</b><br>TALLAL, JOSEPH L. |  |
|                              | <b>Examiner</b><br>KRISTINE K. RAPILLO | <b>Art Unit</b><br>3626                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 10 - 27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 10-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/31/2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/23/2005</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

Claims 1 – 27 are pending.

### ***NOTICE TO APPLICANT***

1. This communication is in response to the amendment filed February 20, 2008. Claims 1, 8, and 9 are cancelled. Claims 2 - 7, 10 - 22, and 24 - 27 are amended. Claims 2 - 7 and 10 - 27 are presented for examination.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "112" (Figure 2A) and "258" (Figure 10) have both been used to designate Major Medical Payment. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 258 (Figure 2A); 314 (Figures 3 and 4); 202 (Figure 7); and, 1166 (Figure 11C).

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 406 (Figure 4).

5. The drawings are objected to because reference characters 604 and 610 in Figure 11A appear to have been transposed in the drawing based on the information in paragraph [0053] of the specification.

### ***Claim Objections***

6. The objections to claims 24 and 25 are hereby withdrawn based on the amendment filed February 20, 2008.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 2 – 7 and 10 – 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 – 7, 12 – 18, 21 -23, and 26 - 28 of copending Application No. 10/620,904 (Tallal). Although the conflicting claims are not identical, they are not

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patentably distinct from each other because all the limitations from the claims of U.S. Application Number 10/620,903 are covered in the claims of U.S. Application 10/620,904.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. The following table is a comparison of all obvious type double patenting claims. The differences in the claims have been bolded, and a summary of the rejection is included in the row directly below the affected claims.

| Application 10/620,903  | Reference: Application 10/620,904  |
|---|--|
| 2. The method as recited in claim 20, wherein the discount price list is a variable discount price list that tracks a known standard <b>pharmaceutical</b> price list.  | 2. The method as recited in claim 26, wherein the discount price list is a variable discount price list that tracks a known standard <b>service/good</b> price list. |
| Regarding claim 2, the standard pharmaceutical price list and the standard service/good price list serve the same function in that they both track a standard price list, therefore, claim 2 of this is not patentably distinct from claim 2 of the reference application.  |  |
| 3. The method as recited in claim 20, wherein the membership fee is paid by the individual  | 3. The method as recited in claim 26, wherein the membership fee is paid by the individual   |
| Regarding claim 3, a pharmacy benefit manager is providing the same function as a network provider. Each function assumes the responsibility to oversee a health care plan (including pharmaceuticals), in which the pharmacy benefit manager and network provider are the recipients of the membership fees used join the pharmaceutical benefit program or health care plan. Therefore, claim 3 of this application is not patentably distinct from claim 3 of the reference application. |  |
| 4. The method as recited in claim 20, wherein the membership fee is paid by the individual's employer.  | 4. The method as recited in claim 26, wherein the membership fee is paid by the individual's employer.   |
| Regarding claim 4: Claim 4 is not patentably distinct from claim 4 of the reference application, therefore, claim 4 is obvious.   |  |
| 5. The method as recited in claim 20, wherein the membership fee is paid by the individual's business.  | 5. The method as recited in claim 26, wherein the membership fee is paid by the individual's business.   |

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|---|---|
| Regarding claim 5: Claim 5 is not patentably distinct from claim 5 of the reference application, therefore, claim 5 is obvious.   |   |
| 6. The method as recited in claim 20, wherein the membership fee is a renewal fee.  | 6. The method as recited in claim 26, wherein the membership fee is a renewal fee.  |
| Regarding claim 6: Claim 6 is not patentably distinct from claim 6 of the reference application, therefore, claim 6 is obvious.   |   |
| 7. The method as recited in claim 20, wherein the member includes his/her family in the <b>pharmaceutical benefit program</b> .   | 7. The method as recited in claim 26, wherein the member includes his/her family in the <b>health care plan</b> .   |
| Regarding claim 7, a pharmaceutical benefit program is an off-shoot of a health care plan – a health care plan provides for medical services, whereas a pharmaceutical benefit program provides for prescription drug medication (which are generated from a medical service visit). Therefore, claim 7 is obvious. |   |
| 10. The method as recited in claim 20, wherein the basic listings are provided to <b>pharmaceutical companies</b> free of charge.   | 12. The method as recited in claim 26, wherein the basic listings are provided to <b>medical service/good providers</b> free of charge.   |
| Regarding claim 10: Claim 10 is not patentably distinct from claim 12 of the reference application, therefore, claim 10 is obvious.   |   |
| 11. The method as recited in claim 20, wherein the premium listings are provided to <b>pharmaceutical companies</b> upon payment of a premium listing fee.  | 13. The method as recited in claim 26, wherein the premium listings are provided to <b>medical service/good providers</b> upon payment of a premium listing fee.  |
| Regarding claim 11: Claim 11 is not patentably distinct from claim 13 of the reference application, therefore, claim 11 is obvious.   |   |
| 12. The method as recited in claim 20, wherein the premium listings include a link to a customizable web page for the <b>pharmaceutical company</b> that is accessible via a global telecommunications network.   | 14. The method as recited in claim 26, wherein the premium listings include a link to a customizable web page for the <b>medical service/good providers</b> that is accessible via a global telecommunications network. |

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| Regarding claim 12: Claim 12 is not patentably distinct from claim 14 of the reference application. Claim 12 refers to a web page for a pharmaceutical company whereas, claim 14 of the reference application refers to a web page for a medical service/good provider. The same system can be used for the pharmaceutical company and medical service/good provider, therefore, claim 12 is obvious. |  |
| 13. The method as recited in claim 20, wherein the premium listings include a link to the <b>pharmaceutical company's</b> web site.   | 15. The method as recited in claim 26, wherein the premium listings include a link to the <b>medical service/good provider's</b> web site.   |
| Regarding claim 13: Claim 13 is not patentably distinct from claim 15 of the reference application, therefore, claim 13 is obvious.   |  |
| 14. The method as recited in claim 20, wherein the premium listings are customized for each <b>pharmaceutical company</b> .   | 16. The method as recited in claim 26, wherein the premium listings are customized for each <b>medical service/good provider</b> .   |
| Regarding claim 14: Claim 14 is not patentably distinct from claim 16 of the reference application, therefore, claim 14 is obvious.   |  |
| 15. The method as recited in claim 20, wherein the discount price list and the <b>pharmaceutical</b> listing is accessible via a global telecommunications network.   | 17. The method as recited in claim 26, wherein the discount price list and the <b>medical service/good provider</b> listing is accessible via a global telecommunications network.           |
| Regarding claim 15: Claim 15 is not patentably distinct from claim 17 of the reference application, therefore, claim 15 is obvious.   |  |
| 16. The method as recited in claim 20, wherein the discount price list and the <b>pharmaceutical</b> listing are searchable by the members using one or more search criteria.   | 18. The method as recited in claim 26, wherein the discount price list and the <b>medical service/good provider</b> listing are searchable by the members using one or more search criteria. |
| Regarding claim 16: Claim 16 is not patentably distinct from claim 18 of the reference application, therefore, claim 16 is obvious.   |  |
| 17. The method as recited in claim 20, further comprising the step of providing one or more advertisements by the <b>pharmacy benefit</b>   | 21. The method as recited in claim 26, further comprising the step of providing one or more advertisements by the <b>network provider</b> to the   |

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| <b>manager</b> to the members.   | members.  |
| Regarding claim 17, a pharmacy benefit manager is providing the same function as a network provider, as per claim 20. Therefore, claim 17 of this application is not patentably distinct from claim 21 of the reference application.   |   |
| 18. The method as recited in claim 17, wherein an advertiser pays the <b>pharmacy benefit manager</b> an advertising fee to provide the advertisements to the members.   | 22. The method as recited in claim 21, wherein an advertiser pays the <b>network provider</b> an advertising fee to provide the advertisements to the members.  |
| Regarding claim 18, a pharmacy benefit manager is providing the same function as a network provider, as per claim 20. Therefore, claim 18 of this application is not patentably distinct from claim 22 of the reference application.   |   |
| 19. The method as recited in claim 18, wherein the advertisement provided to a member is based on one or more search criteria used to search the <b>pharmaceutical</b> listing.  | 23. The method as recited in claim 21, wherein the advertisement provided to a member is based on one or more search criteria used to search the <b>medical service/good provider</b> listing.  |
| Regarding claim 19: Claim 19 is not patentably distinct from claim 23 of the reference application, therefore, claim 19 is obvious.  |   |
| <p>20. A method for providing a <b>pharmaceutical benefit program</b> comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the <b>pharmaceutical benefit program</b>; and</p> <p>providing a discount price list and a <b>pharmaceutical</b> listing to the members that regulates the cost of <b>pharmaceuticals</b> provided to the members by a <b>pharmacy benefit manager</b> such that the members pay the <b>pharmacy benefit manager</b> in-full directly for any <b>pharmaceuticals</b> provided to the members based on the discount price list, and wherein the <b>pharmaceutical</b> listing comprises basic listings and premium listings for the <b>pharmaceuticals</b>.</p> | <p>26. A method for providing a <b>health care plan</b> comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the <b>health care plan</b>;</p> <p>obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>providing a discount price list and a <b>medical service/good provider</b> listing to the members that regulates the cost of <b>services/goods</b> provided to the members by the <b>medical service/good providers</b> such that the members pay the <b>medical service/good providers</b> in-full directly for any <b>services/goods</b> rendered to the members based on the discount price list, and wherein the <b>medical service/good provider</b> listing comprises basic and premium listings for</p> |



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|   | the <b>medical service/good provider</b> .  |
| <p>Regarding claim 20:</p> <ul style="list-style-type: none"> <li>• A pharmacy benefit manager is providing the same function as a network provider.</li> <li>• The term pharmaceuticals is encompassed by the generic term of services/goods.</li> </ul> <p>Therefore, claim 20 of this application is not patentably distinct from claim 26 of application 10/620,904.</p>  |   |
| <p>21. A computer program embodied on a computer readable medium executable by a server for providing a <b>pharmaceutical benefit program</b> comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the <b>pharmaceutical benefit program</b>; and</p> <p>a code segment for providing a discount price list and a <b>pharmaceutical</b> listing to the members that regulates the cost of <b>pharmaceuticals</b> provided to the members by a <b>pharmacy benefit manager</b> such that the members pay the <b>pharmacy benefit manager</b> in-full directly for any <b>pharmaceuticals</b> provided to the members based on the discount price list, and wherein the <b>pharmaceutical</b> listing comprises basic listings and premium listings for the <b>pharmaceuticals</b>.</p> | <p>27. A computer program embodied on a computer readable medium executable by a server for providing a <b>health care plan</b> comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the <b>health care plan</b>;</p> <p>a code segment for obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>a code segment for providing a discount price list and a <b>medical service/good provider</b> listing to the members that regulates the cost of <b>services/goods</b> provided to the members by the <b>medical service/good providers</b> such that the members pay the <b>medical service/good providers</b> in-full directly for any <b>services/goods</b> rendered to the members based on the discount price list, and wherein the <b>medical service/good provider</b> listing comprises basic and premium listings for the <b>medical service/good provider</b>.</p> |
| <p>Regarding claim 21:</p> <ul style="list-style-type: none"> <li>• A pharmacy benefit manager is providing the same function as a network provider, as per claim 20.</li> <li>• The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 20.</li> </ul> <p>Therefore, claim 21 of this application is not patentably distinct from claim 27 of application 10/620,904.</p>  |   |
| <p>22. An apparatus for providing a <b>pharmaceutical benefit program</b> comprising:</p> <p>a server,</p> <p>one or more storage devices communicably</p>  | <p>28. An apparatus for providing a <b>health care plan</b> comprising:</p> <p>a server;</p>  |

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|---|---|
| <p>coupled to the server, the one or more data storage devices containing a discount price list and a <b>pharmaceutical</b> listing to the members that regulates cost of <b>pharmaceuticals</b> provided to the members by a <b>pharmacy benefit manager</b> such that the members pay the <b>pharmacy benefit manager</b> in-full directly for any <b>pharmaceuticals</b> provided to the members based on the discount price list, and wherein the <b>pharmaceutical</b> listing comprises basic listings and premium listings for the <b>pharmaceuticals</b>;</p> <p>a communications interface communicably coupled to the server that allows a member to access the discount price list; and</p> <p>wherein the member is an individual that has paid a membership fee to join the <b>pharmaceutical benefit program</b>.</p> | <p>one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list and a <b>medical service/good provider</b> listing provided to one or more members of the health care plan that regulates the cost of services/goods provided to the members of the <b>health care plan</b> by a <b>medical service/good provider</b> such that the member pays the <b>medical service/good provider</b> in-full directly for any <b>services/goods</b> rendered to a member based on the discount price list, and wherein the <b>medical service/good provider</b> listing comprises basic and premium listings for the <b>medical service/good provider</b>;</p> <p>a communications interface communicably coupled to the server that allows a member to access the discount price list; and</p> <p>wherein the member is an individual that has paid a membership fee to join the <b>health care plan</b>.</p> |
| <p>Regarding claim 22:</p> <ul style="list-style-type: none"> <li>• A pharmacy benefit manager is providing the same function as a network provider, as per claim 20.</li> <li>• The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 20.</li> </ul> <p>Therefore, claim 22 of this application is not patentably distinct from claim 28 of application 10/620,904.</p>  |   |

### ***Claim Rejections - 35 USC § 101***

10. The 35 U.S.C. 101 rejection of claim 1 is hereby withdrawn based on the amendment filed February 20, 2008.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 – 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée, (<http://web.archive.org/web/20011130030647/http://carentree.com>, 2001) in view of Lipton, et al., herein after Lipton, ("Pharmacy benefit management companies: Dimensions of performance", Annual Review of Public Health. Palo Alto: 1999. Vol. 20, page 361), further in view of Goch ("A New Card Deal." Best's Review. Oldwick: Jul 2002 (vol. 103, Iss. 3; page 73).

In regard to Claim 20 (currently amended), Care Entrée teaches a method for providing a pharmaceutical benefit program comprising the steps of receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program (paragraph 10).

Care Entrée fails to teach a method providing a discount price list and a pharmaceutical listing to the members that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list, and wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceuticals.

Lipton teaches a method providing a discount price list and a pharmaceutical listing to the members that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager, and wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceuticals (paragraphs 7, 41- 45 and 111).

Lipton fails to teach a method in which the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list.

Goch teaches a method in which the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list (paragraph 20). Goch was cited in the first office action and provides supplemental information in regard to the Care Entrée reference.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method in which the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list as taught by Goch with the motivation of ensuring a discounted cost for medical and/or pharmaceutical products (paragraph 18).

In regard to Claim 2 (currently amended), Care Entrée teaches the method recited in claim 20.

Care Entrée fails to teach a method wherein the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list.

Lipton teaches a method wherein the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list (paragraph 7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list as taught by Lipton with the motivation of managing drug costs and services (paragraphs 32 through 34).

In regard to Claim 3 (currently amended), Care Entrée teaches the method as recited in claim 20, wherein the membership fee is paid by the individual (paragraph 10).

In regard to Claim 4 (currently amended), Care Entrée teaches the method as recited in claim 20, wherein the membership fee is paid by the individual's employer (paragraph 67).

In regard to Claim 5 (currently amended), Care Entrée teaches the method as recited in claim 20, wherein the membership fee is paid by the individual's business (paragraph 67). The Examiner interprets an individual's employer to be equivalent to an individual's business. In either case, the individual is provided the opportunity to offer employees (including self) a supplemental health care plan.

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In regard to Claim 6 (currently amended), Care Entrée teaches the method as recited in claim 20, wherein the membership fee is a renewal fee (paragraph 6).

In regard to Claim 7 (currently amended), Care Entrée teaches the method as recited in claim 20, wherein the member includes his/her family in the pharmaceutical benefit program (paragraph 10).

13. Claims 10 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée, Lipton, and Goch, further in view of Ferguson et al. (U.S. Patent Number 5,819,092), herein after Ferguson.

In regard to Claim 10 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

Care Entrée and Lipton fail to teach a method wherein the basic listings are provided to pharmaceutical companies free of charge.

Ferguson teaches a method wherein the basic listings are provided to pharmaceutical companies free of charge (column 13, line 66 through column 14, line 12).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the basic listings are provided to pharmaceutical companies free of charge as taught by Ferguson with the motivation of providing a tool to entice a company into purchasing the premium listings using a system in which payments are required for the premium listing (column 14, lines 13 – 19).

In regard to Claim 11 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

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Care Entrée and Lipton fail to teach a method wherein the premium listings are provided to pharmaceutical companies upon payment of a premium listing fee.

Ferguson teaches a method wherein the premium listings are provided to pharmaceutical companies upon payment of a premium listing fee (column 14, lines 6 – 12 and column 18, lines 33 – 35).

The motivation to combine the teachings of Care Entrée, Lipton, and Ferguson is discussed in the rejection of claim 10.

In regard to Claim 12 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

Care Entrée and Lipton fail to teach a method wherein the premium listings include a link to a customizable web page for the pharmaceutical company that is accessible via a global telecommunications network.

Ferguson teaches a method wherein the premium listings include a link to a customizable web page for the pharmaceutical company that is accessible via a global telecommunications network (column 14, lines 6 – 19 and column 7, lines 38 – 42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the premium listings include a link to a customizable web page for the pharmaceutical company that is accessible via a global telecommunications network as taught by Ferguson with the motivation of allowing a user to create online services using existing information (column 7, lines 1 – 4). Examples of possible existing information include a pharmaceutical medication database and a pharmaceutical company.

In regard to Claim 13 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

Care Entrée and Lipton fail to teach a method wherein the premium listings include a link to the pharmaceutical company's web site.

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Ferguson teaches a method wherein the premium listings include a link to the pharmaceutical company's web site (column 14, lines 6 – 19 and column 7, lines 37 – 42).

The motivation to combine the teachings of Care Entrée and Lipton is discussed in the rejection of claim 12.

In regard to Claim 14 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

Care Entrée and Lipton fail to teach a method wherein the premium listings are customized for each pharmaceutical company.

Ferguson teaches a method wherein the premium listings are customized for each pharmaceutical company (column 14, lines 6 – 19 and column 7, lines 37 – 42).

The motivation to combine the teachings of Care Entrée and Lipton is discussed in the rejection of claim 12.

In regard to Claim 15 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

Care Entrée and Lipton fail to teach a method wherein the discount price list and the pharmaceutical listing is accessible via a global telecommunications network.

Ferguson teaches a method wherein the discount price list and the pharmaceutical listing is accessible via a global telecommunications network (column 14, lines 6 – 19 and column 7, lines 37 – 42). The Examiner interprets the discount price list to be a function of the directory look up disclosed by Ferguson. It provides information to users of a pharmacy benefit plan.

The motivation to combine the teachings of Care Entrée and Lipton is discussed in the rejection of claim 12.

In regard to Claim 16 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

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Care Entrée and Lipton fail to teach a method wherein the discount price list and the pharmaceutical listing are searchable by the members using one or more search criteria.

Ferguson teaches a method wherein the discount price list and the pharmaceutical listing are searchable by the members using one or more search criteria (column 10, lines 62 – 65). Ferguson discloses a method where the users are allowed to perform searches and specify the search criteria.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the discount price list and the pharmaceutical listing are searchable by the members using one or more search criteria as taught by Ferguson with the motivation of enabling users to search listings or entries in a directory by a variety of techniques including names, categories, and full text search (column 14, lines 10 – 12).

In regard to Claim 17 (currently amended), Care Entrée and Lipton teach the method as recited in claim 20.

Care Entrée and Lipton fail to teach a method further comprising the step of providing one or more advertisements by the pharmacy benefit manager to the members.

Ferguson teaches a method further comprising the step of providing one or more advertisements by the pharmacy benefit manager to the members (column 14, lines 6 – 12 and column 14, lines 21 – 31). Ferguson discloses a method of online classified advertisements, which are available using hyperlinked documents.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method further comprising the step of providing one or more advertisements by the pharmacy benefit manager to the members as taught by Ferguson with the motivation of increasing the sales of a pharmaceutical company by the use of advertisements in the discount list provided by the Pharmacy Benefit Manager (column 9, lines 54 – 56). An online service can be used as a tool to enable electronic commerce. In this case, the online service would advertise a pharmaceutical company's products, which a member could then present to his/her health care provider.



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In regard to Claim 18 (currently amended), Care Entrée and Lipton teach the method as recited in claim 17.

Care Entrée and Lipton fail to teach a method wherein an advertiser pays the pharmacy benefit manager an advertising fee to provide the advertisements to the members.

Ferguson teaches a method wherein an advertiser pays the pharmacy benefit manager an advertising fee to provide the advertisements to the members (column 18, lines 33 – 35).

The motivation to combine the teachings of Care Entrée, Lipton, and Ferguson is discussed in the rejection of claim 17, and incorporated herein.

In regard to Claim 19 (currently amended), Care Entrée and Lipton teach the method as recited in claim 18.

Care Entrée and Lipton fail to teach a method wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing.

Ferguson teaches a method wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing (column 14, lines 6 - 12). Searches can be conducted based on names, categories, and/or full text searches.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing as taught by Ferguson with the motivation of introducing a revenue generating tool by charging a fee for the online service (column 14, lines 30 – 31).

14. Claims 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée and Lipton, and further in view of Ferguson.

In regard to Claim 21 (currently amended), Care Entrée teaches a pharmaceutical benefit program comprising receiving a membership fee from one or more individuals to become members of the

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pharmaceutical benefit program (paragraph 10). Care Entrée fails to teach a computer program embodied on a computer readable medium executable by a server for providing the pharmaceutical benefit plan or a code segment providing a discount price list and a pharmaceutical listing to the members that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list and wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceuticals .

Lipton teaches a discount price list and a pharmaceutical listing to the members that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list and wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceuticals (paragraphs 7, 41 – 45, and 111). Lipton fails to teach a computer program embodied on a computer readable medium executable by a server for providing the pharmaceutical benefit plan or a code segment providing a discount price list and a pharmaceutical listing to the members.

Ferguson teaches a computer program embodied on a computer readable medium (column 2 , lines 39 – 50) executable by a server (column 7, lines 42 – 47) and a code segment (column 2, lines 39 – 50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a computer program embodied on a computer readable medium executable by a server for providing the pharmaceutical benefit plan or a code segment as taught by Ferguson with the motivation of generating and executing a fast, user friendly online system (column 4, lines 18 -20).

In regard to Claim 22 (currently amended), Care Entrée teaches an apparatus for providing a pharmaceutical benefit program wherein the member is an individual that has paid a membership fee to join the pharmaceutical benefit program (paragraph 10). Care Entrée fails to teach a server and one or

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more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list and a pharmaceutical listing to the members that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list, and wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceuticals; a communications interface communicably coupled to the server that allows a member to access the discount price list.

Lipton teaches a discount price list and a pharmaceutical listing to the members that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list, and wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceuticals; a communications interface communicably coupled to the server that allows a member to access the discount price list (paragraphs 7, 41 – 45, and 111). Lipton fails to teach a server and one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list.

Ferguson teaches a server (column 7, lines 42 - 47) and one or more storage devices communicably coupled to the server (column 7, lines 41 – 49), and the one or more data storage devices (column 1, lines 44 – 49).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a server and one or more storage devices communicably coupled to the server, the one or more data storage devices as taught by Ferguson with the motivation of increasing accessibility and availability of the pharmaceutical listing and discount price list (column 2, lines 7 – 9).

In regard to Claim 23 (original), Care Entrée and Lipton teach a direct point-of-sale system comprising: a network of one or more pharmacies (paragraph 53) and one or more customers having access to the network of one or more pharmacies (paragraphs 53 and 54).

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Care Entrée and Lipton fail to teach a variable discount drug price list web site on a global telecommunications network that tracks a known standard drug price list that regulates the price of drugs to the customers by the pharmacies and wherein the customer pays the network of pharmacies in-full directly for drugs on the variable discount price list; and a basic or a premium drug price listing on the variable discount drug price list web site, wherein the premium drug price listing provides a link to a separate page about the drug.

Ferguson teaches a variable discount drug price list web site on a global telecommunications network that tracks a known standard drug price list that regulates the price of drugs to the customers by the pharmacies and wherein the customer pays the network of pharmacies in-full directly for drugs on the variable discount price list (column 14, lines 13 – 19) and a basic or a premium drug price listing on the variable discount drug price list web site, wherein the premium drug price listing provides a link to a separate page about the drug (column 14, lines 13 – 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a variable discount drug price list web site on a global telecommunications network that tracks a known standard drug price list that regulates the price of drugs to the customers by the pharmacies and wherein the customer pays the network of pharmacies in-full directly for drugs on the variable discount price list; and a basic or a premium drug price listing on the variable discount drug price list web site, wherein the premium drug price listing provides a link to a separate page about the drug as taught by Ferguson with the motivation of providing a system in which a user can view a discount, as well as basic or premium drug price listings via a global telecommunication network (column 7, lines 36 - 42).

In regard to Claim 24 (currently amended), Care Entrée and Lipton teach the direct point of sale system of claim 23.

Care Entrée and Lipton fail to teach a system in which a separate page about the drug is defined further as being a link to the web site on a global telecommunications network of the drug company.

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Ferguson teaches a system in which a separate page about the drug is defined further as being a link to the web site on a global telecommunications network of the drug company (column 14, lines 13 – 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system in which a separate page about the drug is defined further as being a link to the web site on a global telecommunications network of the drug company as taught by Ferguson with the motivation of creating a link between the drug, the discount drug price, and the pharmaceutical company on a global communication system (column 10, lines 55 – 58). By creating this link, an association is generated between the various online documents.

In regard to Claim 25 (currently amended), Care Entrée and Lipton teach the direct point of sale system of claim 23.

Care Entrée and Lipton fail to teach a system wherein the separate page about the drug is defined further as an advertisement for that specific drug.

Ferguson teaches a system wherein the separate page about the drug is defined further as an advertisement for that specific drug (column 14, lines 13 – 19 and lines 21 – 31).

The motivation to combine the teachings of Care Entrée, Lipton, and Ferguson is discussed in the rejection of claim 24, and incorporated herein.

In regard to Claim 26 (currently amended), Care Entrée and Lipton teach the direct point of sale system of claim 23.

Care Entrée and Lipton fail to teach a system where the separate page about the drug is defined further as a web page with several drugs advertised by a single manufacturer.

Ferguson teaches a system where the separate page about the drug is defined further as a web page with several drugs advertised by a single manufacturer (column 14, lines 13 – 19 and lines 21 – 31).

The motivation to combine the teachings of Care Entrée, Lipton, and Ferguson is discussed in the rejection of claim 24, and incorporated herein.

In regard to Claim 27 (currently amended), Care Entrée and Lipton teach the direct point of sale system of claim 23.

Care Entrée and Lipton fail to teach a system wherein the basic and premium listings comprises a drug name, drug strength and a price.

Ferguson teaches a system wherein the basic and premium listings comprises a drug name, drug strength and a price (column 7, lines 10 – 18 and column 13, line 66 through column 14, line 1).

The motivation to combine the teachings of Care Entrée, Lipton, and Ferguson is discussed in the rejection of claim 24, and incorporated herein.

### ***Response to Amendment***

15. Applicant's arguments filed February 20, 2008 have been fully considered but they are not persuasive. Applicant's arguments will be address herein below in the order in which they appear in the response filed.

#### **Claims 20 – 22**

(1) In regard to claims 20 – 22, the applicants arguments are not persuasive as the limitations claimed are taught by the Care Entrée program. The applicant argues that the PBM client is a self-insured employer, not a member or individual to which pharmaceuticals are provided. The Examiner disagrees in that the Care Entree program is a managed health care program which negotiates the cost of pharmaceuticals for individual members who have paid a member ship fee, as discussed in the rejection of claim 20. Lipton discloses a method in which PBM's represent groups (i.e. employers, HMO's).

Therefore, the claims are rejected under 35 U.S.C. 103 as obvious over Care Entrée and Lipton in view of Goch. Care Entrée teaches a health management system in which Care Entrée acts as a PBM, comprising collecting membership fees and the costs associated with medical procedures and/or

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pharmaceuticals. Care Entrée illustrates that a PBM can represent an individual and/or a group (i.e. employers) – see paragraphs 36 and 65 of Care Entrée.

Lipton discloses a method in which PBM's represent groups (i.e. employers, HMO's).

Goch notes that Care Entree requests funds upfront in an escrow account to pay for medical procedures, which thereby reads on the limitation of payments in-full to the PBM (Goch: paragraph 20). The Examiner interprets pharmaceuticals associated with a medical procedure too be inclusive of the medical procedure.

The difference between the Care Entrée and the Lipton subject matter is that a PBM in the Care Entrée system collects fees and costs of medical procedures/pharmaceuticals from an individual, whereas Lipton collects from groups or organizations. The Goch reference is an article describing the Care Entrée system, and supports the Care Entrée reference by supplementing the information described in <http://web.archive.org/web/20011130030647/http://carentree.com>.

Since each element (collect of fees and costs of medical procedures/pharmaceuticals) and the function of the PBM are shown in the prior art, albeit shown as separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the collection of fees/costs from the group or organization of Lipton for the collection of fees/costs from individuals of Care Entree.

Thus, the simple substitution of one know element for another producing a predictable result renders the claim obvious.

(2) The applicant argues that the discount lists are not provided to the individuals or members to which the pharmaceuticals are provided. The Examiner disagrees in that Lipton discloses a method in which purchasers (which refer to an individual or group, see above) obtain copies of proposed formularies (Lipton: paragraph 111). As stated above, in the response to (1), Care Entrée illustrates that a PBM can represent individuals and/or groups (Care Entree: paragraphs 36 and 65). In addition, Care Entree discloses discounts provided to members for medical and pharmaceutical services (Care Entrée: paragraph 22). Therefore, the applicant's arguments are rendered non-persuasive.

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(3) The applicant argues that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide members with a pharmaceutical listing containing basic and premium listings of pharmaceuticals. The Examiner disagrees in that Ferguson teaches an online system in which members can search a directory (column 4, lines 33 – 50), which the Examiner interprets as a basic listing. The directory can include hyperlinks (equating the directory to a premium listing) which would direct the member to a web page containing advertisements and/or information regarding a particular pharmaceutical company or drug (column 26, lines 8 – 24).

Claims 2 – 7 and 10 – 19 are dependent on claim 20, therefore, the same rationale for rejection is applied.

#### Claim 23

In regard to claim 23, the applicant argues that it would not have been obvious to provide customers with a variable discount price list web site with basic or premium drug price listing. The Examiner disagrees in that Ferguson explicitly teaches an online system including a website and global telecommunications (column 7, lines 36 – 37). In addition, Lipton discloses discount price lists (i.e. formularies, pharmacy networks). Therefore, the applicant's arguments are not persuasive.

Claims 24 – 27 are dependent upon claim 23, therefore, the same rationale for rejection is applied.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/Robert Morgan/  
Primary Examiner, Art Unit 3626